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Scott C. Harris

DIY-C1

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EXAMINER

KRAMER, JAMES A

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/064,439	<b>Applicant(s)</b> HARRIS, SCOTT C.	
	<b>Examiner</b> Jocelyn Greimel	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-16, 18, 19 and 22-64 is/are pending in the application.
- 4a) Of the above claim(s) 33-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2-16, 18, 19 and 22-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

This action is in response to Applicant's petition filed under 37 CFR 1.181 on March 27, 2009 asking for Supervisory Review of the Examiner's Final rejection mailed March 27, 2009.

The petition has been delegated by the Group Director to the examiner of record in this application to be treated as a request for reconsideration. The reason for this delegation is that the points raised in the petition are agreed with and the relief requested will be granted in full.

Accordingly, the Finality of the action dated March 27, 2009 is officially withdrawn and this action is being made non-final.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

***Claims 10, 15, 19 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

**Claim 10** recites the limitation "said plain text messages" in line 2. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes Applicant intended to depend claim 10 from claim 2. In order to advance prosecution, the Examiner will interpret claim 10 to depend from claim 2. However, the claim should be amended to correct this issue.

**Claim 15** depends from claim 10 and therefore is rejected for the reason explained in the preceding paragraph.

**Claim 19** is indefinite because it lacks clarity and precision. Specifically this dependent claim attempts to further limit the "first e-mail" of independent claim 22 by requiring the first email to include "information that requests specified information from the website." This limitation, however contradicts the scope of said "first e-mail" as defined in claim 22. Namely

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lines 7-8 of claim 22, state, “wherein said receiving comprises receiving an instruction to bid on an item on an Internet based auction.” The Examiner asserts that when taken as a whole, the scope of the claim 19 is indefinite because it is unclear whether the first email is an instruction to bid on an item or a request for information.

**Claim 26** recites the limitation "said e-mail message" in line 1. There is insufficient antecedent basis for this limitation in the claim. Specifically, claim 19 (from which claim 26 depends) recites two messages with information, namely on lines 1-2 “said first e-mail includes information that . . .” and on line 3 the system sends a response "including specified information." Accordingly, it is unclear which message with information claim 26 is trying to limit.

**Claim 27** recites the limitation "said email" on line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 27, depends on claim 26, which depend on claim 19, which ultimately depends on independent claim 22. When claim 27 is taken as a whole, there appear to be two email messages sent. Namely, a “first email message” found in claim 22 lines 2 and claim 19 line 1 and a “response including specified information” found in claim 19, line 3. Accordingly, it is unclear which message is being limited.

With respect to claims 19 and 26-27, while the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention the Examiner will attempt to offer an interpretation in order to advance prosecution.

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Upon review of the specification as well as the full scope of the narrowest claim (claim 27), it appears Applicant is attempting to claim a system that receives a bid (as claimed in claim 22), sends the bidder an email notifying them when they've been out bid (as claimed in claim 26) and affords the bidder an opportunity to reply to said outbid email with an instruction to increase his/her bid (as claimed in claim 27). Accordingly, this is the interpretation that will be given to the claims in this Office action.

Applicant is encouraged to amend the claims to clarify the scope of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claims 6-9, 11-14, 16, 18-19 and 22-32, as best interpreted by the Examiner are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,835,896 to Fisher et al. (hereinafter Fisher).***

**With respect to claims 8, 22, and 24:**

Fisher teaches a web server, producing a web page which is available on the Internet (see column 6; lines 21-29 and column 7, lines 7-10).

Fischer further teaches an information translating part associated with said web server which receives e-mail messages and translates said e-mail messages into a form which can interact with said webpage being produced by said web server (see column 6, lines 54-65).

Fischer further teaches wherein said web server is a server that hosts auctions of items for sale and maintains auction bids for items for sale over the Internet (see column 7, lines 7-10 and column 6, lines 3-13).

Fischer further teaches wherein said information translating part also sends e-mail messages that include information about items in said auctions for sale over the Internet, on which items a user has been outbid (see column 6, lines 48-50).

**With respect to claims 6, 26 and 28:**

Fisher teaches wherein said information translating part accepts e-mail messages which include instructions to change bids on items in auctions for which a user has been previously outbid (see column 6, lines 46-62 and column 8; lines 15-29).

**With respect to claims 7 and 25:**

Fisher teaches wherein said information translating part also sends e-mail messages indicative of information about said auctions (see column 6; lines 50-52).

**With respect to claims 9 and 32:**

Fischer further teaches wherein said information translating part produces and sends messages which include a session identification indicator that identifies said auction information (see column 6; lines 50-54). Examiner notes when Fisher teaches that “electronic mail notification messages preferably contain the relevant merchandise information, the current high bid, the bid increment, etc.” this clearly represents Applicant’s “session identification identifier that identifies said auction information.”

**With respect to claim 11:**

Fisher teaches wherein said information translating part also sends e-mail messages indicative of actions occurring on said web page (column 6; line 48-57). Examiner notes that at the very least an email message notifying a bidder that he/she has been outbid, as taught by



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Fisher represents Applicant's "e-mail messages indicative of actions occurring on said web page."

**With respect to claim 12:**

Fisher teaches wherein said e-mail messages include a session ID indicative of said actions (column 6; line 48-57). Examiner notes that under the broadest reasonable interpretation of this limitation the e-mail message need only contain an ID that indicates an action. In the case of Fisher, the teaching of an e-mail notification to bidders who have been out-bid, represents an email with a session ID indicating a user has been out bid (said action).

**With respect to claims 13 and 30:**

Fisher teaches wherein said session ID is included as part of a return address in the e-mail message (see column 6; lines 46-57). Examiner notes that the ability to, "enter a new bid by replying to the electronic mail message and sending it back to the system" as taught by Fisher represents Applicant's session ID included as part of a return address.

**With respect to claim 14:**

Fisher teaches wherein the session ID is used to interact with said auction on said Web page (see column 6; lines 46-57). As explained above with respect to claim 12, under the broadest reasonable interpretation of this limitation the e-mail message need only contain an ID. In the case of Fisher the email notification includes information which identifies the auction and allows the user to reply to or enter a new bid by replying to the electronic mail message.

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Examiner notes that this functionality of Fisher represents Applicant's "session ID is used to interact with said auction on said Web page".

**With respect to claims 16, 27, 29 and 31:**

Fisher teaches wherein said information translating part detects a new (increased) bid amount as part of a sent message (see column 6; line 54-57).

**With respect to claim 18:**

Fisher teaches further comprising sending a second e-mail that has instructions on a specific interaction with said web page (see column 6, lines 48-51). Examiner notes that with respect to this claim the "first message" is the "reply" which allows the "bidder to enter a new bid, as this is the message that is "received." Accordingly, the "second message" is the message sent from the system of Fisher with "notification to bidders who have been outbid."

**With respect to claim 23:**

Fisher teaches wherein said web page is an e-commerce site (see column 7; lines 8-11). Examiner notes that an electronic auction site on the Internet is an e-commerce site.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

***Claims 2, 10 and 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of U.S. Patent Number 7,058,582 to Powell (hereinafter Powell).***

**With respect to claim 2**, Fisher (as described in detail above) teaches a system which receives bid information from a user via email, enters the bid information into a computer server and then sends email notices to said user (see rejection above under 35 U.S.C. 102).

**With respect to claim 10**, Fisher teaches wherein said information translating part detects a reply to an email message which reply including a session identification indicator and takes action on a specified auction based on said session identification identifier (see column 8; lines 24-27). Examiner notes that a reply to an email with an increased bid amount represents a

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“reply including a session identification indicator” and acting to increase the user's bid represents " takes action on a specified auction based on said session identification identifier.”

**With respect to claim 15**, the examiner notes that an increased bid amount represents a “new bid” as a bid at that amount has not been submitted. Accordingly an increased bid amount has to be new bid.

**With respect to claims 2, 10 and 15**, Fisher fails to specifically teach wherein the email messages are in plain text form.

Powell teaches a system that accepts email requests in plain text form, parses the text to determine the nature of the request, performs an action associated with the request and sends a return email to the original requestor (see column 2, lines 7-40). Powell teaches that email plain text is a well known standard and using plain text eliminates the need for any specialized knowledge on the part of the user (see column 2, lines 10-13).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the email messages of Fisher to include plain text form as taught by Powell. One of ordinary skill in the art would have been motivated to make this modification in order to use a well known standard and eliminate the need for any specialized knowledge on the part of the user.

**Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Official Notice.**

Fisher, as discussed in detail above (see rejection of claim 8 under 35 U.S.C. 102) fails to specifically state that the user sends emails with either an email pager or a cellular telephone.

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The Examiner takes Official Notice that it was old and well known at the time of the present invention to use email pagers or cellular phones to send and receive email messages. In fact Applicant all but admits as much in the Appeal Brief filed 12/10/2008. On the first paragraph of page 9, Applicant states "This can be done without requiring that thin client to be able to host or display a webpage. Rather, the client needs to be able to send e-mail messages, something that virtually every cell phone can do." Examiner notes that Applicant has not invented a cell phone that sends email nor an email pager, both of these were around long before Applicant's invention. Rather the asserted novelty lies in the system that receives the email messages, regardless of where the messages are generated.

Examiner further takes Official Notice that it is old and well known in the art for email users to employ email pagers and cellular phones for portability (i.e. to receive emails anywhere, not just at a computer terminal).

Accordingly, Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the user client of Fisher to specifically be either an email pager or cellular phone as is old and well known in the art. One of ordinary skill would have been motivated to modify Fisher to include email pagers and cellular phones so that the users of Fisher could place bids and receive notifications anywhere, not just at a computer terminal.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Feinberg.

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**With respect to claim 5**, Fisher (as described in detail above) further teaches a bid validator that receives an email with a bid (see column 8, lines 24-29) then examines the bid for all necessary data (see column 7, lines 54-57).

Fisher fails to specifically teach a user ID and password as part of the email message/necessary data.

Feinberg teaches an automated auction system, in which users are required to submit a username and password with each bid (see column 8, lines 26-32). Feinberg teaches that this is done as a security measure to verify the user (see column 8, lines 26-32).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the data which is received and examined in Fisher to include a username and password as taught by Feinberg. One of ordinary skill in the art would have been motivated to make this modification in order to provide security by verifying the user, as taught by Feinberg.

### ***Conclusion***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
SPE  
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